

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Amit MATE et al.  
Application No.: 10/030,207  
Confirmation No.: 8979  
Filing Date: August 10, 2004  
Title: Method and System for Data Reception Acknowledgment  
Art Unit: 2112  
Examiner: Joseph D. Torres

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

April 11, 2008

**REQUEST FOR CLARIFICATION OF OFFICE ACTION**

Sir:

Applicants gratefully acknowledge the Office Action dated January 11, 2008. However, there are some items in the Office Action that are confusing or incomplete, and applicants request that they be clarified so that applicants are able to respond to the Office Action and to progress the prosecution of this application.

**Objection to Claims 38, 39**

On page 2 of the Office Action, claims 38 and 39 are objected to under 37 CFR 1.75( c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The grounds for the objection don't make sense. The objection states: "Claims 24, fail to recite any structural element further limiting the apparatus of claim 38." But claim 24 does not depend on claim 38. Furthermore,

if the error is that "Claims 24" should be "Claim 39", then the objection should only be taken of claim 39 and should not include claim 38. Applicants are unable to resolve the error and applicants will be adversely affected in trying to reply to the objection unless there is clarification.

#### **Indefiniteness Rejection of Claim 38**

At the top of page 3, claim 38 is rejected under 35 USC 112, second paragraph, as being incomplete "for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections." The rejection goes on to state that the omitted structural cooperative relationships are "structural element further limiting the apparatus of claim 38." Once again, the rejection makes no sense because claim 38 is being rejected because it does not further limit itself? Secondly, it is unclear what is the alleged omission in dependent claim 38, which mentions only the datagram checking unit in the receiver? Applicants are unable to resolve the error and applicants will be adversely affected in trying to reply to the rejection unless there is clarification of the rejection.

#### **Non-statutory Subject Matter Rejection of claim 47**

Claim 47 is directed to a computer program recorded on a tangible medium. Applicants respectfully submit that the Office Action is incomplete because it does not include a substantive answer to applicant's argument against the rejection.


Claim 47 was rejected as being non-statutory subject matter in the Office Action dated May 7, 2007. On page 7 of the Amendment filed on September 7, 2007, applicants traversed the rejection, specifically citing and relying upon the Federal Circuit decision in the Beauregard case as holding that "computer program embodied in a tangible medium" was patentable subject matter (copy of argument attached to this Request). No other arguments were made; as far as applicants are concerned the Beauregard decision is directly on point and definitively decides the issue. At the top of page 4, claim 47 is again rejected under 35 USC 101 as being directed to non-statutory subject matter, but no response is made to applicants' argument based on Beauregard.

According to MPEP 707.07(f), when a rejection is traversed, the Examiner should "take note of the applicant's argument and answer the substance of it." However, the current Office Action does not answer the substance of the argument and makes no statements regarding applicants' reliance on the Beauregard decision. Applicants respectfully request an answer to the argument and an explanation of why the Federal Circuit decision is not dispositive of whether claim 47 is directed to statutory subject matter.

**Conclusion**

For at least the above reasons, applicants respectfully request a supplemental or corrected Office Action.<sup>1</sup> Applicants further request a reply period of at least one month in which to respond to the supplemental or corrected Office Action.

Respectfully Submitted,

  
Robert Bauer, Reg. No. 34,487

Dated: April 11, 2008

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<sup>1</sup> This Request for Clarification is made pursuant to MPEP 710.06, and is not an attempt to respond to the merits of the Office Action.

### **REMARKS**

Claims 23-47 are pending in this application. Claims 23, 35 and 43-47 are independent claims. Claim 47 has been amended by this Amendment.

The Office Action dated May 7, 2007 rejected claim 47 under 35 USC 101 as being directed to non-statutory subject matter. The Office Action also rejected claims 23-42 as being anticipated by U.S. Patent No. 6367045 to Khan, or rendered obvious by the Khan patent in view of other patents, and rejected claims 43-47 as being anticipated by prior art under 35 USC 102(b).

#### **Non-statutory subject matter**

The grounds for the rejection of claim 47 under 35 USC 101 as being directed to non-statutory subject matter is set forth in part 5 on page 4 of the Office Action. Specifically, the rejection states that "[n]either signals nor computer programs fall into any of the statutory categories of invention."

Applicants have amended claim 47 to overcome the rejection. Specifically, applicants have amended claim 47 to require that the computer program be recorded on a tangible medium. See In Re Beauregard, 53 F.3d 1583, 1584 (Fed. Cir. 1995) (noting the PTO's statement that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. 101..."). It is therefore respectfully submitted that claim 47, as amended, is directed to statutory subject under 35 USC 101.

#### **Claims 23-42 - Khan et al patent**

The grounds for the anticipation rejection under 35 USC 102(e) and the obviousness rejections under 35 USC 103(a) of claims 23-42 based on the Khan et al patent are set forth in parts 6 and 8-11 on pages 4-5 and 5-6 of the Office Action. Applicants previously traversed the rejection on the basis that the invention was prior to the filing date of the Khan et al patent, providing a copy of a draft of the UK priority application dated prior to the filing date of the Khan et al patent. The Office Action declines to withdraw the rejection. Instead, it requires a Declaration under 37 CFR 1.131 and also alleges that the draft application is insufficient to show reduction to practice.